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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,382

04/09/2004

Guoqing P. Chen

1603

7590

07/27/2006

Advenchen Laboratories, LLC  
515 Oakbury Court  
Thousand Oaks, CA 91360

EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/821,382

Applicant(s)

CHEN, GUOQING P.

Examiner

Deepak Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 ~~9~~ are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 ~~8~~ are rejected.
- 7) ☒ Claim(s) 10-11 ~~8~~ are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Claims 1-11 are pending in this application.

### *Claim Objections*

Claims 10-11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### *Claim Rejections - 35 USC § 112*

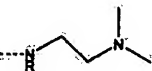
The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In claim 1, it is recited: "A phenylaminopyrimidine **derivative** of formula (I)", wherein the term "**derivative**" may be interpreted as a residue derived from the compounds of the claims, and it is confusing which compounds are derived from the compounds of formula (I). As the claims are drawn specifically to 'A compound', it should be recited as such. Replacing the recitation with -- A phenylaminopyrimidine ~~derivative~~ compound --is suggested.
2. Claim 2 recites the limitation "R<sub>4</sub> is: (a) oxy-lower alkyl aminopyridinyl, (b) lower alkyl

oxy-lower alkyl aminopyridinyl, (c) mono or difluoro substituted lower alkyl aminopyridinyl, (d) amino lower alkyl aminopyridinyl, (e) lower alkylamino lower alkyl aminopyridinyl" in lines 8-30. There is insufficient antecedent basis for this limitation in claim 1 on which claim 2 is dependent. Claim 1 recites a term "oxy-lower alkyl amino" however, does not provide support for a "pyridinyl" substituted on the terminal amino nitrogen. Claim 1 does not provide support for a "pyridinyl" to be substituted on the terminal amino groups of the definitions provided under R<sub>4</sub>, which are described in the specification pages 5-10.

3. Claim 7 recites the limitation "R is hydrogen, lower alkyl, aliphatic, cycloaliphatic or **heterocyclyl radicals**" in line 13, page 48. There is insufficient antecedent basis for this limitation in claim 1 on which claim 7 is dependent. The variable ' R ' is found in the structural fragment, e.g.,  which represents the term "amino lower alkylamino" under the definition of R<sub>4</sub> in claim 1. The specification on page 9 defines the term as "-N<sub>1</sub>-lower alkyl-N<sub>2</sub> groups wherein the amino nitrogen N<sub>1</sub> is substituted by hydrogen, lower alkyl, aliphatic or cycloaliphatic radicals, and the amino nitrogen N<sub>2</sub> is unsubstituted, mono or di-substituted by lower alkyl, aliphatic or cycloaliphatic radicals". The instant recitation of "heterocyclyl radicals" as a substituent on amino nitrogen is not defined within the scope of R<sub>4</sub>.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Manley et al., WO 04/029038 (published April 8, 2004). The instant claims read on reference disclosed compounds, see the compounds of formula 1 (in page 3), and the corresponding species of the compounds of Example 15, 16, etc.
2. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Manley et al., WO 04/029038 (International Filing Date September 26, 2003). The instant claims read on reference disclosed compounds, see the compounds of formula 1 (in page 3), and the corresponding species of the compounds of Example 15, 16, etc.
3. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al., WO 04/099186 (International Filing Date May 26, 2003). The instant claims read on reference disclosed compounds, see the compounds of formula (1) in page 3; the corresponding species in page 9 (the last structural formula under Reaction Scheme 1) and the compounds of Example 4.

**Note:** Applicant cannot rely on the priority benefit based on U.S. Provisional

Application 60/466,883 filed May 2, 2003 to overcome the above rejection(s). The provisional

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application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for the instant claims, see the definition of R<sub>4</sub> which recites an amino nitrogen further substituted with a heterocyclyl radical. The Provisional application does not provide adequate support for this claim limitation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manley et al., WO 04/029038. The reference teaches a generic group of pyrimidine compounds, which embraces applicant's instantly claimed compounds. See formula (1) in page 3, and the compounds of Examples 15, 16, etc. The compounds are taught to be useful as pharmaceutical therapeutic agents having protein kinase activity, see the abstract. Claims 1-7 and 9 are anticipated by the reference as indicated above in the 35 U.S.C. 102 rejection. Claim 8 differs from the reference by reciting specific species of the reference genus. It would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole i.e., as

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therapeutic agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

July 24, 2006